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10/067,108

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EXAMINER

PLAZA CORCORAN, GLADYS JOSEFINA

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 06-04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,108

Applicant(s)

KEMKES, JURGEN

Examiner

Gladys J Piazza Corcoran

Art Unit

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5, 7, 8, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falk (US Patent No. 3,964,946) in view of Lang et al. '063 (US Patent No. 5,182,063) and Baratto (US Patent No. 5,721,041).

Falk discloses a process for producing a three-dimensional surface structure in a paper copy of a picture, the paper copy in the form of a paper poster or photograph with an image side (image bearing sheet) by adhering canvas onto the back surface of the paper copy (column 2, lines 23-50), and then pressing the image side of the paper copy with an embossing roller to form the three-dimensional surface structure (column 2, lines 58-60) and then sealing the structured laminate (column 3, lines 24-30).

It is well known in the embossing arts to use a pair of dies to emboss substrates as an equivalent alternative to rolling the surface with an embossing roller. For example, Lang '063 discloses it is known in the art to produce reproductions with a textured surface by embossing in a press with a matrix in order to provide a reproduction of the textured surface of the original on the reproduction. Lang '063 shows placing the paper copy (embossing material 256) with the image side down onto a matrix (die 240) having a surface structure, the paper copy being equal in size to or

smaller than the matrix, cold surface pressing the material and the matrix at least once to structure the material with the structure of the matrix, removing the resulting structured product after the pressing from the matrix (column 12, lines 1-22). It would have been obvious to one of ordinary skill in the art at the time of the invention to produce the reproduction as shown in Flak by embossing the laminate of the paper copy and the canvas in a press with a matrix as shown by Lang '063 in order to reproduce the surface texture of the original painting on the matrix onto the reproduction material and as a known equivalent alternative to rolling with an embossing roller.

As to the limitation of fixing the paper copy to the matrix, the reference Baratto is cited to show it is well known in the art when embossing reproductions with a matrix, the reproduction is fixed to the matrix (column 7, lines 11-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the reproduction as shown in Flak and Lang '063 by fixing the paper copy to the matrix when embossing in order to properly hold the paper copy in place during embossing as is well known in the art and exemplified by Baratto.

As to the limitation of mounting the laminate under tension onto a frame, Baratto discloses an example of how it is well known in the art to mount reproductions under tension onto frames (column 1, lines 30-33). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the reproduction as shown in Falk and Lang '063 by mounting the laminate under tension onto a frame as it is well known in the art in order to display the reproduction and as further exemplified by Baratto.

As to claim 2, the matrix in Lang '063 is an imprint of an original painting and the image is a copy of the painting. As to claim 3, the matrix in Lang '063 has a canvas textured surface structure (column 3, lines 15-16). As to claim 5, the reference Lang '063 discloses a pressure of 1 ton/in² for pressing one layer of paper. It would have been well within the purview of one of ordinary skill art to select the appropriate pressure for embossing a laminate as the one shown in Falk, such determination is dependent only upon the materials used and the depth of the texture of the matrix desired to be imparted on the laminate.

As to claim 7, Baratto shows it is known in the art to provide a reinforcing layer of paper between the image and the substrate in laminates for forming reproductions (column 8, lines 15-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the reproduction as shown in Falk and Lang '063 by providing a paper covering between the canvas and the paper copy in order to form a reinforcing layer as shown by Baratto.

As to claim 8, Falk discloses using any suitable adhesive. It is unclear whether the example adhesive disclosed in Falk is water soluble. However, Baratto shows it is known in the art to adhere images to substrates using water soluble adhesive in particular in order to provide flexibility to the finished reproduction (column 4, lines 40-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the reproduction as shown in Falk and Lang '063 with a water soluble adhesive as is well known in the art and exemplified by Baratto in order to form a more flexible reproduction.

As to claim 10, Falk discloses sealing the reproduction but does not specifically disclose applying a varnish at a preselected thickness for producing a desired gloss. It is well known in the art when sealing paintings in particular reproductions to apply a varnish at a preselected thickness for producing a desired gloss. For example see the disclosure in Baratto (column 7, line 66 to column 8, line 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the sealing layer in Falk by applying a varnish at a preselected thickness for producing a desired gloss as is well known in the art and exemplified by Baratto in order to form a desired glossy finish.

As to the well known and conventional statements, it is noted that Applicant has not argued the statements. Therefore these statements are considered to be acquiesced by Applicant to be Admitted Prior Art (see MPEP § 2144.03).

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Falk in view of Lang et al. '063 and Baratto as applied to claim 1 above, and further in view of Giorgi (US Patent No. 3,856,592), Lang '734 (US Patent No. 4,971,743) and/or Barnett (US Patent No. 154,576).

It is well known in the art to provide an elastic mate between a press and the materials being pressed in order to provide an evenly distributed pressing force to the materials and to prevent the materials from tearing. Giorgi, Lang '743, and/or Barnett all disclose examples in the art of providing elastic mats in order to protect materials during embossing. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the reproduction as shown in Falk, Lang et al. '063, and Baratto by

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providing an elastic mate between the press and the canvas in order to protect the laminate as is well known in the art and further exemplified by Giorgi, Lang '743, and/or Barnett.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Falk in view of Lang et al. '063 and Baratto as applied to claim 1 above, and further in view of Robinson (US Patent No. 3,880,686).

The matrix in Lang '063 is formed of a metal. Robinson discloses forming a matrix for embossing textures of original paintings out of a synthetic resin (silicone rubber) in order to avoid the costs of forming out of metal (column 1, lines 58-68; column 3, lines 34-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to form the reproduction as shown in Falk, Lang et al. '063, and Baratto with a matrix formed of synthetic resin as is known in the art and shown by Robinson in order to avoid the expense of forming a metal die.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Falk in view of Lang et al. '063 and Baratto as applied to claim 8 above, and further in view of Hulbert (US Patent No. 615,026).

As discussed above, it is known to mount reproductions under tension onto a frame after forming in order to be displayed as shown by Baratto. Whether or not the laminate in Falk is still damp from the water soluble adhesive is only dependent upon the amount of drying the laminate is exposed to prior to mounting. It would have been well within the purview of one of ordinary skill in the art to mount the laminate while still damp from the adhesive particularly in view of the disclosure in Baratto that the

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adhesive allows flexibility to the laminate to reduce cracking. Furthermore, Hulbert shows an example of embossing a laminate image and support where the laminate is left in the press any desired length of time until sufficiently dried (page 2, lines 65-66). Therefore, it would have been well within the purview of one of ordinary skill in the art to remove the laminate and mount on the frame prior to completely drying, only the expected results would be attained. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the reproduction as shown in Falk, Lang et al. '063 and Baratto by mounting the laminate while still damp from the adhesive as is considered within the purview of one of ordinary skill in the art in light of the disclosures by Baratto and Hulbert, only the expected results would be attained.

Response to Arguments

6. Applicant's arguments filed March 22, 2004 have been fully considered but they are not persuasive.

Applicant argues on page 8 that the reference Falk teaches pressing the paper copy of a picture into a backing while the claim 1 requires pressing a laminate into a matrix. It is noted that Applicant argues the references cited individually and not the combination of the references as a whole. Falk teaches laminating a paper copy to a canvas backing and embossing the top surface of the paper backing with a roller. Lang '063 is cited to show that it is known in the art of forming reproductions to emboss a material by placing the image surface of the material face down into a matrix to form the structure of the original painting into the material. Therefore, one of ordinary skill in the art at the time of the invention practicing the method of Falk would readily recognize

embossing the laminate of the paper copy and the canvas backing in Falk by placing the image side of the laminate down onto a matrix in order to emboss the original structure of the painting onto the laminate as shown by Lang '063 and further as an alternative to embossing with a roller.

Applicant argues on page 9 that the reference Lang '063 teaches away from the creation of a laminate in column 12. The recognition of a reference of providing embossing without lamination to a substrate does not teach away from using a laminate, in fact it is further evidence that embossing laminates was known in the art. The statement in column 12 that Applicant refers to does not teach away from the claimed invention, one of ordinary skill in the art not concerned with shrinking would recognize that it is known in the art to embossing laminates against a matrix. As discussed above, one of ordinary skill in the art at the time of the invention performing the method of Falk would readily appreciate embossing the laminate in Falk by placing the image side down on a matrix as a known method in the art of embossing the original texture of the original painting into the laminate as exemplified by Lang '063.

As to the arguments on page 9 that Lang '063 does not teach mounting the laminate under tension onto a frame or sealing the structured laminate, these limitations are respectively met by the references Baratto and Falk, as discussed above.

Applicant argues on pages 9-10 that the reference Baratto relates to creating impressions of paintings using a thermoplastic film in place of a paper copy thus obviating the need for creating a laminate and that one skilled in the art wishing to arrive at the matter in claim 1 would never consult Baratto as its teachings do not apply to

forming paper. The reference Baratto was cited as an example that it is well known in the art when embossing reproductions with a matrix, the reproduction is fixed to the matrix and that it is well known in the art to mount reproductions under tension onto frames. The fact that the reproduction in Baratto is of a thermoplastic film is irrelevant. The level of skill of one of ordinary skill in the art is not to be determined in a vacuum. It is notoriously well known to frame paintings and even reproductions of paintings in frames under tension. Is Applicant asserting that one of ordinary skill in the art would not frame such a reproduction in this notoriously well known manner? Again, Baratto is merely cited as an example to show this well known concept.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J Piazza Corcoran whose telephone number is (571) 272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gladys P. Corcoran
Examiner
Art Unit 1733

GJPC